

Remarks

Claims 1-33 are pending. No claims are added, cancelled, or amended. Reconsideration of the outstanding rejections is requested in view of the accompanying remarks and the declaration of Hisataka Kobayashi (the "Declaration"), a co-inventor of the present application, filed herewith under 37 C.F.R. § 132.

I. Interview Summary

Applicants sincerely thank the Examiner for the courtesy of the telephonic interview held on July 16, 2007. Applicants discussed filing a declaration to remove the Kobayashi references. Applicants also discussed the publication date of Kobayashi I.

II. Claim Rejections – 35 U.S.C. § 102(b)

Rejection Over Kobayashi I

The Office action states that claims 1-10, 12, 13, 15, 17-19, 21, and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kobayashi et al. (*Mol. Imaging* **2003**, 2, 1-10) ("Kobayashi I"). However, Applicants note that Kobayashi I was not published until at least February 11, 2003, less than one year before Applicants filed the present patent application. The Declaration establishes that the article was not accepted for publication or publicly available until after January 13, 2003. Moreover, the face of the document indicates that it could not have been published until after February 6, 2003, as it was not accepted for publication until that date. Kobayashi I thus does not qualify as prior art under § 102(b).

Further, Kobayashi I is unavailable as prior art under § 102(a), as it is the inventors' own work and not that of "another." As explained in the Declaration, the portion of Kobayashi I relied upon by the Office action is work actually performed and described in Kobayashi III, described in further detail below. For the reasons set forth below, Kobayashi I described the inventors' own work and thus is not prior art under § 102(a). *See also In re Katz*, 687 F.2d 450, 455 (C.C.P.A. 1982) (stating that "we hold that authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter described in the article.") Applicants respectfully request the withdrawal of the § 102(b) rejections of claims 1-10, 12, 13, 15, 17-10, 21, and 22.

Rejection Over Kobayashi II

The Office action states that claims 1, 2, 4-9, 12, 13, 15-19, 21, and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kobayashi et al. (*Magn. Reson. Med.* **2003**, 50, 758-765) ("Kobayashi II"). However, Applicants note that Kobayashi II was not published until September 26, 2003, less than one year before Applicants filed the present patent application. Applicants have submitted

a webpage from the publisher of Kobayashi II indicating that the article was published online on September 26, 2003. Applicants note that Kobayashi II itself states, on page 758, that it was not received until March 18, 2003, less than one year before the filing date of Applicants' patent application. Kobayashi II thus does not qualify as prior art under § 102(b).

Further, the Declaration establishes that all of the co-authors of Kobayashi II are either listed as inventors on the present application or were merely co-authors of Kobayashi II, and not co-inventors of any subject matter disclosed therein. For example, the Declaration states that the non-inventor co-authors provided assistance such as technical assistance in carrying out the experiments, providing animal models for the experiments, providing an imaging agent used for comparative purposes, and reviewing draft manuscripts. Thus, Kobayashi II is not available as prior art under § 102(a), as it is not the work of "another." See also *In re Katz*, 687 F.2d 450, 455 (C.C.P.A. 1982) (stating that "we hold that authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter described in the article.") Applicants respectfully request the withdrawal of the § 102(b) rejections of claims 1, 2, 4-9, 12, 13, 15-19, and 22.

Rejection Over Kobayashi III

The Office action states that claims 1, 2, 4-9, 12, 13, 15, 18, 19, 21, and 22 are rejected under 35 U.S.C. § 102(a) as being anticipated by Kobayashi et al. (*Cancer Research* **2003**, 63, 271-276) ("Kobayashi III"). The Declaration establishes that all of the co-authors of Kobayashi III are either listed as co-inventors on the present application or are not inventors of the subject matter disclosed in Kobayashi III. For example, the Declaration states that the non-inventor co-authors provided assistance such as technical assistance in carrying out the experiments, providing animal models for the experiments, and reviewing draft manuscripts. Thus, Kobayashi III is not available as prior art under § 102(a), as it is not the work of "another." See also, *In re Katz*, 687 F.2d 450, 455 (C.C.P.A. 1982) (stating that "we hold that authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter described in the article.") Applicants thus respectfully request the withdrawal of the § 102(a) rejections of claims 1, 2, 4-9, 12, 13, 15, 18, 19, 21, and 22.

III. Claim Rejections – 35 U.S.C. § 103(a)

Rejection Over Suga, Kobayashi I, and Baker

The Office action states that claims 1-10, 12-25, 27-29, and 31-33 are rejected under 35 U.S.C. § 103(a) as being obvious over Suga et al. (*Acta Radiologica* **2003**, 2, 1-10) ("Suga") in view of Kobayashi I and U.S. Patent 6,471,968 to Baker, Jr., et al. ("Baker"). The Office action states that Suga discloses sentinel lymph node mapping using MR lymphography employing various contrast agents, including Gd-

chelates. The Office Action further states that those of ordinary skill in the art would have been motivated to use the Gd-PAMAM dendrimer contrasts agents of Kobayashi I in the method of Suga. Baker is cited as suggesting the use of a fluorescently tagged dendrimer conjugate, as recited in claims 11 and 30.

Without conceding the Office action's statements regarding Suga, Kobayashi I, and Baker, Applicants respectfully note that, as discussed above, Kobayashi I is not available as prior art against the present application. The remaining references fail to teach or suggest all elements of Applicants' claims, such as the specifically claimed DAB and PAMAM dendrimer conjugates. Accordingly, Applicants respectfully request the withdrawal of the 103(a) rejections of claims 1-10, 12-25, 27-29, and 31-33.

Rejection Over Suga, Kobayashi II, and Baker

The Office action states that claims 1, 2, 4-9, 12-29, and 31-33 are rejected under 35 U.S.C. § 103(a) as being obvious over Suga in view of Kobayashi II and Baker. The Office action's statements regarding the disclosures of Suga and Baker have already been discussed. The Office action further states that those of ordinary skill in the art would have been motivated to use the Gd-PAMAM dendrimer contrasts agents of Kobayashi II in the method of Suga. As before, Baker is stated to suggest the use of a fluorescently tagged dendrimer conjugate, as recited in claims 11 and 30.

Without conceding the Office action's statements regarding Suga, Kobayashi II, and Baker, Applicants respectfully note that, as discussed above, Kobayashi II is not available as prior art against the present application. The remaining references fail to teach or suggest all elements of Applicants' claims, including the specifically claimed PAMAM and DAB dendrimer conjugates. Accordingly, Applicants respectfully request the withdrawal of the 103(a) rejections of claims 1, 2, 4-9, 12-29, and 31-33.

Rejection Over Suga, Kobayashi III, and Baker

The Office action states that claims 1, 2, 4-9, 12-16, 18-26, 29, and 31-33 are rejected under 35 U.S.C. § 103(a) as being obvious over Suga in view of Kobayashi III and Baker. The Office action's statements regarding the disclosures of Suga, Kobayashi III, and Baker have already been discussed. The Office action further states that those of ordinary skill in the art would have been motivated to use the Gd-PAMAM dendrimer contrasts agents of Kobayashi III in the method of Suga. As before, Baker is stated to suggest the use of a fluorescently tagged dendrimer conjugate, as recited in claims 11 and 30.

Without conceding the Office action's statements regarding Suga, Kobayashi III, and Baker, Applicants respectfully note that, as discussed above, Kobayashi III is not available as prior art against the present application. The remaining references fail to teach or suggest all elements of Applicants' claims, including the specifically claimed PAMAM and DAB dendrimer conjugates. Accordingly, Applicants

respectfully request the withdrawal of the 103(a) rejections of claims 1, 2, 4-9, 12-16, 18-26, 29, and 31-33.

IV. Conclusion

Applicants submit that the present application is in condition for allowance. If the Examiner has any questions regarding the application or this response, the Examiner is encouraged to call Applicants' attorney, Ryan A. Heck, at (775) 824-0104.

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Respectfully submitted,

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